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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/930,453	08/16/2001	Akihiro Ouchi	862.C2332	1321

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EXAMINER

HOLTON, STEVEN E

ART UNIT PAPER NUMBER

2629

DATE MAILED: 10/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/930,453

Applicant(s)

OUCHI ET AL.

Examiner

Steven E. Holton

Art Unit

2629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4, 5 and 8-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 5 and 8-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is made in response to applicant's amendment filed on 5/23/2006. Claims 1,2,4, 5, and 8-16 are currently pending in the application. An action follows below:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 provides the limitations of a first and second mode with the second mode displaying images from storage when in the second mode. However, claim 14, from which claim 15 depends, recites the "display means displays said handwritten image based on said data stored in said storage means, when said data is stored in said storage means". It is unclear if the selection of the second mode would override the nature of displaying stored data when data is stored, or if stored data is always displayed regardless of the mode of operation.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al. (USPN: 4814552), hereinafter Stefik in view of Silverbrook et al. (USPN: 6822639), hereinafter Silverbrook.

Regarding claim 1, Stefik discloses a handwriting input system capable of transmitting a handwritten image to an computer system (abstract, lines 1-8). The system described by Stefik possess an input device of a pen and receives for determining handwritten input by a user (Fig. 1b, elements 14-17) the handwritten information is then displayed on the screen of the computer connected to the handwriting system (Fig. 8, element 40; col. 8, lines 2-10).

Stelik does not discuss a system for determining the status of the wireless transmission link between the computer and the input system.

Silverbrook discloses an electronic pen input system for wireless transmission of handwritten data to an external printer and networked computer system. Silverbrook further provides a range check to determine if the electronic input pen is within transmission distance of the external systems (col. 2, line 52- col. 3, line 5; col. 42, lines 4-10). Silverbrook determines if the external system can receive data (is within range)

Art Unit: 2629

and transmits data when in range. If the input system cannot transmit to the external system, the information is buffered and transmitted later when it is determined that the external system can receive data (col. 42, lines 6-7). The ability to determine if transmission is possible requires a first determining means and the ability to transmit buffered data would require a second determining means to tell if data had been previously buffered.

At the time of invention it would have been obvious to one skilled in the art to modify the teachings of Stefik with the teachings of Silverbrook to provide a wireless input system for handwritten data to be transmitted to a computer system. It would have been obvious that the wireless system of Stefik may be positioned or moved to a location and no longer be able to transmit to the external computer; and using Silverbrook to modify the system to include the buffering and retransmitting system, the system of Stefik could be provided protection against lost data.

Regarding claim 2, the system of Silverbrook uses the data buffer when it is determined that data cannot be transmitted to external systems and transmitted when the input device is able to transmit the data (col. 42, lines 13-15).

Regarding claim 4, Stefik uses the system to enter hand drawn characters and information to the computer (col. 1, lines 5-6).

Regarding claim 5, Silverbrook transmits locations of the input device to determine the coordinate information of the handwritten input.

Regarding claim 8, Stefik uses a computer display which is connectable to the input system through the wireless link.

Regarding claim 9, Stefik transmits data in either synchronous or asynchronous timing modes depending on how the timing of transmissions is controlled (col. 6, line 66 – col. 7, line 15).

Regarding claim 10, Silverbrook provides area and tag identification indexes to the digital ink data (Table 4).

Regarding claim 11, the Examiner notes that using a removable memory card or a hardwired on-board memory would be a matter of design choice for one skilled in the art. The buffer memory of Silverbrook could be replaced with a removable memory card so that the input system could be operated for longer periods of time off-line before having full memory and being unable to store more input information.

Regarding claims 12 and 13, Stefik discloses a system with transmitters positioned to determine the location of the input stylus. The location of the transmitters could be anywhere in relation to the board able to find location of touches including the side of the board. Also making the transmitters removable would be a matter of design choice depending on making a system that could be changed from one input location to another or having a fixed location.

Regarding claim 14, the modification of Stefik with Silverbrook disclose all of the limitations of this claim. The addition of a data generation means for generating the handwriting data would be inherent within the systems of Silverbrook and Stefik so that the handwriting information could be transmitted to the external systems. The other transmission and storage means are the same as in claim 1.

Regarding claim 16, the teachings of Stefik and Silverbrook disclose the method of transmitting data from an electronic board apparatus to an external computer similar to the devices described in claims 1 and 14.

Response to Arguments

4. Applicant's arguments with respect to claims 1,2, 4,5, and 8-16 have been considered but are moot in view of the new ground(s) of rejection.

Because of the new grounds of rejection the finality of the previous action is removed and this action is made non-final to allow the applicant a chance to respond.

A transmission system for determining if an external system can receive data and storing the data until transmission is possible is described by Silverbrook for use with a handwriting input system. This data transmission technique could be applied to any system involving transmission of data from one device to an external system to make sure that no data is lost by transmitting when the external system is unable to receive.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven E. Holton whose telephone number is (571) 272-7903. The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amr Awad can be reached on (571) 272-7764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2629

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Steven E. Holton
Division 2629
October 29, 2006

AMR A. AWAD
SUPERVISORY PATENT EXAMINER

A handwritten signature in black ink, appearing to read "Amr A. Awad", with a stylized flourish extending from the end.